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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Katsunari OHSONO, et al.

: EXAMINER: PALABRICA, R

SERIAL NO: 10/080,709

:

FILED: FEBRUARY 25, 2002

: GROUP: 3641

FOR: CASK

PROVISIONAL ELECTION

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ASSISTANT COMMISSIONER OF PATENTS  
WASHINGTON, DC 20231

SIR:

In response to the Election of Species Requirement stated in the Official Action dated April 12, 2002, Applicants provisionally elect Species A, as shown in Figures 1-4, and identify Claims 1 and 4 as readable on the elected species. Further, as required by the Examiner, Applicants provisionally elect a single species of the dummy pipe shown in Fig. 6A.

Applicants respectfully traverse the outstanding election requirement for several reasons.

First, the outstanding Office Action simply asserts that “[t]his application contains claims directed to the ... patentably distinct species of the claimed invention....” However, MPEP §816 states the following:

If the particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given....

The outstanding Election Requirement merely provides the aforementioned conclusory statement and does not present particular reasons for such a holding. Hence, Applicants respectfully submit that in the absence of any annunciated basis, the PTO has not carried its burden of proof stated in MPEP §816.

Further, MPEP §806.04(f) states:

Claims to be restricted to different species must be mutually exclusive.

The outstanding Election Requirement omits any statement or basis for finding the Claims “mutually exclusive.” Therefore, the PTO has not carried the burden implied by MPEP §806.04(f), and on that basis, Applicants further traverse the Election Requirement.

Furthermore, MPEP §803 states the following:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Claims 1, 6 and 11 of the present application are directed to a cask. Thus, it appears that all claims in the present application are part of an overlapping search area and that a search for Claims 1 and 4 would necessarily include a search directed to the claims readable on the non-elected species as well. Applicants therefore respectfully submit that there is no undue burden on the Examiner to search all the claims under MPEP §803, and traverses the Election of Species Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single disclosed species be withdrawn, and that a full examination on the merits of each of Claims 1-12 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Registration No: 25,599  
Robert T. Pous  
Registration No: 29,099  
Attorneys of Record



**22850**

Tel: (703) 413-3000  
Fax: (703) 413-2220  
GJM/RTP/AY:si  
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